

### REMARKS

The range for the amount of starting material is a new element to claim 1. Support for the insertion of the amount of starting material in claim 1 is found in paragraph 0030, lines 4-5. Claim 7 recited these amounts and is now canceled as redundant. The range for the time of addition of starting material is also a new element to claim 1. Support for the insertion of this new element in claim 1 is found in paragraph 0031, lines 10-11. These elements have been inserted in response to the rejection under 35 USC §112, first paragraph.

New claim 9 is identical to amended claim 1 but describes the agitation as, "at an intensity which does not increase the agglomeration of the globular particles formed." Support for this description is in paragraph 0029, lines 3-6.

#### Rejections Under 35 USC §112, first paragraph

There is no basis for finding the specification non-enabling for preparing particles at unspecified levels of agitation. The specification is presumed to be objectively enabling. The burden is on the examiner to show otherwise. *In re Marzocchi*, 439 F.2d 220, 169 U.S.P.Q. 367 (CCPA 1971). The examiner refers to teachings within paragraph 0029 to support the finding of non-enablement with respect to the level of agitation. This paragraph states in a relevant part, "...the intensity of agitation should not be too vigorous because agglomeration of primary particles is increased under too vigorous agitation not to give a uniformly globular particle configuration." Applicant describes preferred levels of agitation in this paragraph teaching that the agitation "should" not be too vigorous. There is no indication that the level of agitation is critical to the invention. Therefore, there is no evidence to support the finding of non-enablement with respect to unspecified levels of agitation.

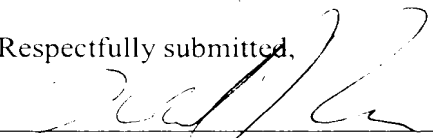
As to the use of preferred levels of agitation as recited in new claim 9, there is sufficient disclosure within the specification, accompanied by guidance within the examples and the prior art, for one skilled in the art to obtain an intensity of agitation which does not increase the agglomeration of the globular particles formed without undue experimentation. Nothing more than the normal level of routine experimentation exercised by skilled workers in the field on a

day-to-day basis is needed to obtain a preferred level of agitation within the equipment employed. Enablement is not precluded if some experimentation is necessary, *Hybritech Inc. V. Monoclonal Antibodies, Inc.*, 802 F. 2d1367, 231 USPQ 81 (Fed Cir. 1986).

Claims 1 and 9 incorporate the limitations of claim 7, which was found to be allowable. Therefore, applicants submit all pending claims are in a form suitable for allowance.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

  
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Attorney Docket No.: YAMAM-176

Date: December 17, 2002

**VERSION WITH MARKINGS TO SHOW CHANGES MADE  
IN THE CLAIMS:**

Please amend claim 1 as follows:

1. (Amended) A method for the preparation of globular particles of a silicone resin which comprises the steps of:

(a) preparing an aqueous alkaline solution having a pH value in the range from 10.0 to 13.0 by the addition of a basic compound selected from the group consisting of ammonia and water-soluble amine compounds to water;

(b) adding a water-soluble electrolytic compound of a metal to the aqueous alkaline solution, within a time from  $1 \times 10^{-5}$  to  $1 \times 10^{-2}$  mole/liter; and

(c) adding, to the aqueous alkaline solution, an organotrialkoxy silane compound or a partial hydrolysis condensation product thereof as the starting material, in an amount in the range from 5 to 100 parts by weight per 100 parts by weight of the aqueous alkaline solution within a time from 30 minutes to 100 hours, under agitation to effect hydrolysis condensation reaction of the starting material.

Please add new claim 9 as follows:

9. (New) A method for the preparation of globular particles of a silicone resin which comprises the steps of:

(a) preparing an aqueous alkaline solution having a pH value in the range from 10.0 to 13.0 by the addition of a basic compound selected from the group consisting of ammonia and water-soluble amine compounds to water;

(b) adding a water-soluble electrolytic compound of a metal to the aqueous alkaline solution in a concentration of the metallic ions in the range from  $1 \times 10^{-5}$  to  $1 \times 10^{-2}$  mole/liter; and

(c) adding, to the aqueous alkaline solution, an organotrialkoxy silane compound or a partial hydrolysis condensation product thereof as the starting

material, in an amount in the range from 5 to 100 parts by weight per 100 parts by weight of the aqueous alkaline solution, within a time from 30 minutes to 100 hours, under agitation, at an intensity which does not increase the agglomeration of the globular particles formed, to effect hydrolysis condensation reaction of the starting material.